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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,209	12/31/2003	Paul A. Puniello	20002.0384	6677

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EXAMINER
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HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/748,209

Applicant(s)

PUNIELLO ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly amended claims 15-21 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The cover layer is a single cover layer that incorporates a first and second material.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al. (USPN 5833553).

Regarding claims 1 and 16-15, Sullivan et al. discloses a golf ball product comprising a core and a cover surrounding the core wherein the cover includes an inner layer of a first material and an outer layer of a second material. Sullivan et al. notes that the inner and outer layer may optionally contain additives such as dyes, pigment, etc.

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Furthermore, the material in which is used for the cover layer is ionomer which is inherently transparent. One ordinarily skilled in the art would have drawn therefrom that one can add any type of additive to any layer of the cover so long as the properties of the layers are deteriorated', therefore, making the addition of the additives obvious.

Regarding claims 2-5, Sullivan et al. discloses the inner layer and the outer layer having thicknesses wherein the combined thickness of the layers is at least 3.8mm, wherein each layer is at least 0.25mm (0.010 inch). One having ordinary skill in the art would have drawn from Sullivan et al. that the thickness of inner layer can be greater or less than the thickness of the outer layer; and therefore, would have been obvious to do so long as the combined thickness of the two layers are at least 3.8mm. If in doubt, regarding claim 3, Example 4 shows a golf ball having an inner cover being greater in thickness than the outer cover wherein the outer layer has a thickness of 0.070 inch. Applicant does not teach why approximately 0.065 is critical to attain the invention; therefore, it is submitted that Sullivan et al. would have resulted in the same properties of that of the applicant's invention, *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Regarding claim 6, Sullivan et al. discloses the second material being harder than the first material (See Figure 2).

Regarding claims 7-11, Sullivan et al. discloses the first and second materials being greater than 60 Shore D wherein the difference between the two layers being at most 5 units.

Regarding claims 12 and 13, Sullivan et al. discloses that more than two cover layer may be placed over the core. Furthermore, one of the cover layers would be the structural equivalent to that of an intermediate layer.

Regarding claim 14, Sullivan et al. notes that a finish coating may be placed over the fabricated golf ball wherein the golf ball includes a core and cover layers (See Column 18, lines 30 through 34).

### ***Response to Arguments***

Applicant's arguments filed 7/22/05 have been fully considered but they are not persuasive. Applicant argues that the rejection of claims 1-14 is improper. The examiner disagrees. Applicant argues that there is no suggestion of a translucent outer cover. Contrary to what the applicant argues the purpose of the translucent layer and the color layer are merely for aesthetic purposes. Wherein the applicant notes that the translucent cover covering the colored creates a shadow appearance or a more appealing look (See Page 21 of applicant's specification). Patentability cannot be granted based on aesthetic designs. Furthermore, claim 1 requires the inner layer to be made of a translucent material and the outer layer made of an opaque material. The coloring of the layer would be meaningless if the inner layer is translucent and the outer layer is opaque. In regards to the hardness of the outer and inner layer, the applicant uses the language "about". The term "about" is interpreted as being "within the vicinity of". This language does not exclude the "5" from being part of the range. In reference to Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). The above argument set forth that the limitations claimed by the applicant are

met. The applicant even discusses the case in which the above argument would set forth that the same situation is present. Applicant argues that the instant invention attains high spin rates, but nowhere in the applicant's specification presents this, only that the golf ball has different characteristics, in which the term "characteristics" is very broad. The examiner believes the claimed invention to provide nothing more than what is presented by Sullivan et al.; therefore, the above action has been furnished.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



EUGENE KIM  
PRIMARY EXAMINER